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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,405	01/09/2002	Kia Silverbrook	WSM010US	2054
24011	7590	04/22/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			SONG, SARAH U	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,405

Applicant(s)

SILVERBROOK, KIA

Examiner

Sarah Song

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's communication filed on January 20, 2005 has been carefully studied by the Examiner. The arguments advanced therein, considered together with the amendments made to the claims, are persuasive and the rejections based upon prior art made of record in the previous Office Action are withdrawn. Claims 1 and 4 are amended. Claim 11 is canceled. Claim 20 is newly added. Claims 1-10 and 12-20 are pending. Claims 13-19 are withdrawn from further consideration.

Claim Objections

2. Claim 4 is objected to because of the following informalities: "the at least one second optical device" lacks proper antecedent basis. For purposes of examination, Claim 4 will be examined as depending from claim 3 in order to provide antecedent basis for the limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

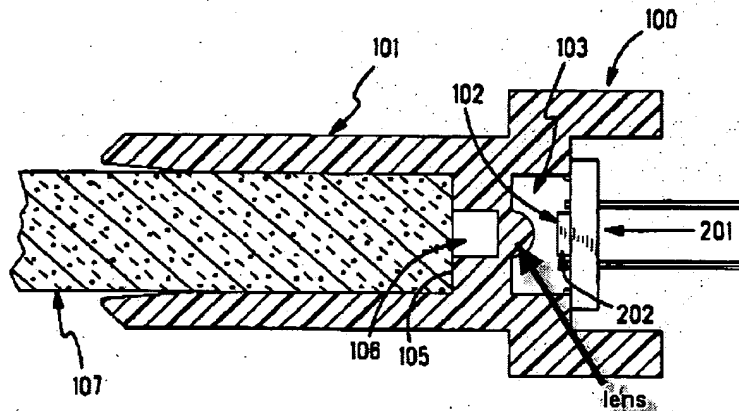
4. **Claims 1, 2, 5, 6, 8, 9, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett (U.S. Patent 5,692,083 newly cited).**

5. Regarding claim 1, Bennett discloses an optical fiber terminator package including:

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- a. a semiconductor chip 201 having a top surface and a bottom surface and including at least one first optical device 202 which emits or receives electromagnetic radiation at one or more wavelengths from the top surface;
- b. a first hollow cap 100, said cap being a one-piece molded cap comprising a central portion and four perimeter walls (for mating with the four walls of ridge 205) extending from a perimeter edge of the central portion with a free edge of each perimeter wall bonded to the top surface (see claim 3) to provide a first cavity 103 which, in plan view, overlays at least part or all of at least one light emitting device, said central portion including:

at least one region (lens) which is at least substantially transparent or translucent to electromagnetic radiation at said one or more wavelengths, the at least one region including at least one shaped recess 106.



6. Regarding claim 2, the cap further includes at least one first attachment means 101 for attaching an electromagnetic radiation transmitting cable or fiber to the cap, whereby at least some electromagnetic radiation transmitted between the at least one first optical device and the cable or fiber passes through said at least one region (lens).

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7. Regarding claim 5, the package, as noted above, includes four perimeter walls.

Therefore, the package comprises a second perimeter wall as claimed.

8. Regarding claim 6, the package further includes at least one recess 106 in the central portion.

9. Regarding claims 8 and 9, the device may be either a light emitting device or a photoreceptor (column 3, lines 30-33).

10. Regarding claim 20, the at least one region includes a shaped recess 106 forming a refractive lens for focusing electromagnetic radiation emitted or receive by the at least one first optical device.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 3, 4, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett.**

13. Regarding claims 3, 4 and 12, Bennett does not expressly disclose a second optical device, a second attachment means, or wherein at least one second region refracts said electromagnetic radiation passing therethrough.

14. However, arrayed transmitters/receivers are well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second optical device, a second attachment means, and at least one second region that

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refracts said electromagnetic radiation passing therethrough in order to increase the communications capacity. Furthermore, it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. MPEP 2144.04(VI)(B).

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. **Claims 1-10, 12 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 7, 11-13 and 16 of U.S. Patent No. 6,870,259 in view of Bennett.**

17. U.S. Patent 6,870,259 claims all of the limitations of claims 1-12 and 20 except for the one-piece molded cap. However, Bennett discloses a one-piece molded cap and also discloses that such an integrally molded piece simplifies design and assembly, and reduces overall cost of the finished product (column 4, lines 29-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the claimed invention of U.S. Patent 6,870,259 to further comprise a one-piece molded cap in order to simplify design and assembly, and also to reduce costs. Claims 1, 2 and 7 correspond to Patent claim 1. Claim 3 corresponds to Patent claim 4. Claim 4 corresponds to Patent claim 5. Claim 5

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corresponds to Patent claim 11. Claim 6 corresponds to Patent claim 12. Claims 8 and 9 corresponds to Patent claim 13. Claim 10 corresponds to Patent claim 16. Claim 12 corresponds to claim 7. Claim 20 corresponds to Patent claim 3.

Response to Arguments


18. Applicant's arguments with respect to claims 1-10, 12 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Song whose telephone number is 571-272-2359. The examiner can normally be reached on M-Th 7:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 571-272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sarah Song
Patent Examiner
Group Art Unit 2874